UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,678	10/27/2000	Ryosuke Taniguchi	400906	5239

23548 7590 11/13/2002

LEYDIG VOIT & MAYER, LTD
700 THIRTEENTH ST. NW
SUITE 300
WASHINGTON, DC 20005-3960

EXAMINER
BUDD, MARK OSBORNE

ART UNIT	PAPER NUMBER
2834	

DATE MAILED: 11/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
697698	Taniguchi et al
Examiner	**Group Art Unit**
M. Budd	2834

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address---

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 10-10-02.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-12, 14-20 and 26 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☒ Claim(s) 1-12, 14-20 and 26 is/are rejected.

☐ Claim(s)_____ is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s)._____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other_____

Office Action Summary

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12, 14-20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi (448).

Taniguchi teaches (figs. 15, 17 and 26-36) a laminated magnetostrictive oscillator with the necessary excitation coils. The laminates are located within a support. The ends of the laminations do not directly engage the support structure. Instead, a coupling member is provided at each end of the laminations. Claims 1 and 2 calls for direct coupling between each end of the laminates and the support. Claim 15 does not explicitly claim direct contact between the laminations and the support frame. Thus in claim 15, use of spaces is not excluded by the claim language. Claim 26 specifically includes at least one spacer, and does not exclude a spacer at each end. A prestress is provided to the laminations of Taniguchi by expanding the spacers. Applicant provides a prestress via shrink-fitting the laminations into the cavity of the support structure with or without spacers between the ends of the laminations and the support surfaces. Structurally, the completed transducer does not know how it was made. The shrink-fit recitations considered either are statements of desired function which do not define structurally from Taniguchi, or are 'method' "laminations" which again do not modify the actual structure claimed. Regarding claims 1 and 2, it is noted that the omission of an element with the

consequent loss of its function has long been held to be within the skill expected of the routineer; and therefore would have been obvious to one of ordinary skill in the art. In re Karlson, 136 U.S.P.Q 184.

MARTIN J. BUDD
PRIMARY EXAMINER
ART UNIT 212